

REMARKS

Applicants thank the Examiner for considering the present application. Claims 1-41 are pending in the application.

The present invention relates to an online invention disclosure system 10. Claim 1 is directed to a method of forming an invention disclosure online and includes the steps of forming an invention disclosure online by entering a plurality of selected information portions into a web-based system, after each of the plurality of selected information portions are entered, storing each of the information portions in a central storage location, and allowing access to various users for reviewing the information.

Claim 1 was amended during prosecution to recite that the invention disclosure has selected information portions and that after each of the plurality of selected information portions are entered, each of them are stored in a central storage location.

Claim 17 is a system claim corresponding to the method of claim 1. Claim 17 includes a recitation of a user computer 14, a server 12, and a database 18 coupled to the server 12. The server 12 provides user screens to the users to prompt said users to provide a plurality of disclosure information to the server. The server receives the plurality of disclosure information from the users and stores information in the database after each of the plurality of disclosure information is entered. The sever 12 allows access to the disclosure after storing the plurality of disclosure information within the database.

Claim 23 is similar to claims 1 and 17 with the addition of providing classification information and notifying an evaluator of the classification information.

Claim 37 is a method that allows identification information to be entered into the system and user information is obtained from a central directory system automatically. It should be noted that information portion does not necessarily mean e.g., each digit of an address but may include several pieces of information such as one part of the several parts of a typical disclosure.

Issues

The following issues are presented:

Whether claims 1-3, 7, 9, 16-24, 37-38, and 41 are patentable under 35 U.S.C. §103(a) over *Watanabe* (6,157,947) in view of *Rivette* (2003/0046307).

Whether claims 4-6, 8, 10-15, 25-35, and 39-40 are patentable under 35 U.S.C. §103(a) as being unpatentable over *Watanabe* in view of *Rivette* in further view of *Schneider* (5,987,464).

Argument

THE REJECTION OF CLAIMS 1-3, 7, 9, 16-24, 37-38, and 41 UNDER 35 U.S.C. §103(a)

Claims 1-3, 7, 9, 16-24, 37-38, and 41 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Watanabe* (6,157,947) in view of *Rivette* (5,991,780). Generally, claims 1, 17 are similar in basic scope so the following argument applies equally to both.

The *Watanabe* reference is a method and apparatus for distributing intellectual property. The system is a system that is used to form an information specification by people in various locations around the world. Various pieces of information may be stored to the system. Examples of such pieces are described in Col. 5, beginning on line 34. No real detail is given in the *Watanabe* system as to how the information is provided to the system. It appears from the description that whole documents are uploaded to such a system. The present invention is suitable for invention disclosures in which a plurality of selected information is input. Examples of such information are identifying information such as inventorship, titles, and various description portions. The present invention is a web-based system that allows storage after each portion of the invention disclosure is provided. Therefore, if the web connection is discontinued or interrupted, the information portion will not be lost and the information entry process can be resumed at any time. Other examples of intellectual property are described beginning in Col. 8, line 29, and continue for several pages including the tables. Applicants can find no teaching or suggestion in this application for the proposition of saving the selected information from an invention disclosure after each portion is entered. Applicants therefore respectfully request the reconsideration of this rejection.

Apparently the Examiner agrees with this position on page 4 of the Office Action which states: "Watanabe does not explicitly indicate after each of the plurality of selected information portions are entered, storing each of the information portions in a central storage location." The Examiner then goes on to state: "However, *Rivette* teaches the retrieval of patents is performed by a web client interacting with the enterprise server via the web server (see fig. 166 and 167, data server or web server where the data or information or patent information to be stored for retrieving or updating; section 0486-0489)."

The *Rivette* reference is directed to a computer-based system for selectively displaying patent text and images. Applicants respectfully submit that although patent text and images are disclosed, no teaching or suggestion is provided for disclosure information. Although a central location or library and database is disclosed in the *Rivette* reference, no teaching or suggestion is provided for "after each of the plurality of selected information portions are entered, storing each of the information portions in a central storage location". The Examiner fails to allege this since the Examiner only alleges that the *Rivette* reference has a central storage location. Thus, the rejection is not valid on its face because the Examiner does not allege that either of the references teach that "after each of the plurality of selected information portions are entered, storing each of the information portions in a central storage location".

Applicants respectfully believe that claim 2 is independently patentable. Claim 2 recites that the step of performing includes providing identification information and whereby providing identification information to the web based server, retrieving user information from the directory system in response to the identification information. This is not taught or suggested in the prior art in combination with the recitations of claim 1.

Claim 3 is also believed to be independently patentable for reciting the additional step of prompting the user for classification information. This in combination with the recitations of claim 1 are not taught or suggested in the *Watanabe* and *Rivette* references.

Claim 7 is also believed to be independently patentable for including the further step of prompting an evaluation comprising ranking the disclosure. It should be noted that claim 7 is dependent on claim 4 which is rejected further below. Applicants respectfully believe claim 7 is also allowable for the same reasons that will be set forth below.

Claim 9 is also believed to be independently patentable for further including the step of prompting a patentability review from the patent staff person. Claim 9 is dependent on claim 8.

Both claims 16 and 36 are further recitations of claims 1 and 23, respectively. Both claim 16 and 36 recite the step of accepting a paper submission and wherein the step of forming comprises scanning the paper submission into the database. No teaching or suggestion is provided for these claims in combination with the recitations of the independent claims in the combination of the *Watanabe* and *Rivette* references. Applicants respectfully request the Board to reverse the Examiner's rejection.

Claim 18 is dependent on claim 17 and is also believed to be independently patentable. Claim 18 is directed to the system including a directory system coupled to the server whereby the server retrieves user information from the directory system in response to the identification information. This is similar to that of claim 2 above which is also not taught or suggested in the *Watanabe* and *Rivette* references.

Claim 19 is also believed to be independently patentable. Claim 19 further defines the server as a web server. This in combination with the limitations of claim 17 are not taught or suggested in the combination of the *Watanabe* and *Rivette* references.

Claim 20 is also believed to be independently patentable. Claim 20 further recites that the user computer comprises a web browser for accessing said server. This in combination with the limitations of claim 17 are not taught or suggested in the combination of the *Watanabe* and *Rivette* references.

Claim 21 is also believed to be independently patentable. Claim 21 includes a CAD file viewer coupled to the web browser. This in combination with the recitations of claim 17 are not taught or suggested in the *Watanabe* and *Rivette* references.

Claim 22 recites a web single log in. Claim 22 is also believed to be independently patentable since a web single log in along with the recitations of claim 1 are not taught or suggested in the art.

Claim 24 is also believed to be independently patentable. Claim 24 further defines the step of forming and includes providing identification information and whereby providing identification information at the web based server, retrieving user information from the directory system in response to the identification information. This in combination with the limitations of claim 23 are not taught or suggested in the combination of the *Watanabe* and *Rivette*.

With respect to claim 37, Applicants have reviewed the *Watanabe* reference and can find no teaching or suggestion for a user entering identification information to retrieve user information based on the identification information to create at least a portion of the invention disclosure. In general, such systems appear to be systems by which documents are moved rather than a document forming system such as that of the present invention. The goals of document forming are quite a bit different than the goals of document moving. Applicants respectfully request the Examiner for reconsideration of these claims since the limitations in the claims are not taught or suggested by the *Watanabe* reference.

In response to the above argument, the Examiner points to column 6, lines 8-55, Fig. 4, and column 11, lines 20-25, and column 15, lines 27-38. The Examiner states that: "Watanabe discloses IP users can retrieve IP information as well as user information in the server such as a manager's name, user name, and a group name via the CORBA server." Applicants have reviewed these sections and can find no teaching or suggestion of the steps of claim 37. Namely, although retrieving information stored in the system is disclosed, no teaching or suggestion is used for coupling the user information with the disclosure and retrieving the user information from the directory system in response to the identification information. Thus, claim 37 is used to form the disclosure rather than retrieve information from the disclosure once it is stored into the system. It appears that the sections cited by the Examiner correspond to the retrieving of information once the information has been stored into the system rather than to forming a disclosure in a database. The *Rivette* reference also does not teach or suggest the limitations of claim 37. Applicants respectfully request the Board to reverse the rejection of claim 37 as well.

Claim 38 is also believed to be independently patentable for the same reasons set forth above. Claim 38 is a further limitation of claim 37 and includes the further step of prompting the user for classification information.

Claim 41 is also a further limitation of claim 40 which is a further limitation of claim 37. Claim 40 includes the further step of prompting a patentability review from the patent staff person. Claim 41 in combination with the recitations of claim 37 are not taught or suggested in the *Watanabe* reference.

**THE REJECTION OF CLAIMS 4-6, 8, 10-15, 25-35, AND 39-40 OVER WATANABE
IN VIEW OF RIVETTE IN FURTHER VIEW OF SCHNEIDER (5,987,464).**

Claim 23 includes the same limitations of claim 1 and the additional steps of prompting the user for classification information; notifying an evaluator in response to the classification information; and prompting an evaluation from the evaluator.

The Applicants note the several deficiencies of *Watanabe* and *Rivette* as described above. The *Schneider* reference is a method and system for periodically updating data records having an expiry time. No teaching or suggestion is provided in the *Schneider* reference for forming an invention disclosure in an online-type system. The *Schneider* system is a database with expiry times. Although the Examiner cites various sections (col. 5, line 20-54 and col. 1 lines 38-53 and col2. lines 40-47), Applicants maintains the *Schneider* system is not

an on-line invention disclosure system. Therefore, because *Schneider* does not overcome the deficiencies of the *Watanabe* reference described above, Applicants respectfully request the Examiner for reconsideration of this rejection as well.

Claim 4 is also believed to be independently patentable for the same reasons set forth above. Claim 4 includes the further step of notifying an evaluator in response to the classification information and prompting an evaluation from the evaluator. This in combination with the recitations of claim 1 are not taught or suggested in the combination of the *Watanabe*, *Rivette* or the *Schneider* references.

Claim 5 is also believed to be independently patentable and includes the step of notifying an evaluator by generating an e-mail and providing a hyperlink to the disclosure in the e-mail. This in combination with the recitations of claim 4 and the recitations of claim 1 are not taught or suggested by the combination of the *Watanabe*, *Rivette* and *Schneider* references.

Claim 6 is also believed to be independently patentable for the same reasons set forth above with respect to claim 4 and claim 1. Claim 4 recites the further step of prompting an evaluation comprising scheduling an evaluation meeting. This in combination with the limitations of claim 4 and claim 1 are not taught or suggested in the teachings of the *Watanabe*, *Rivette* and *Schneider* references.

Claim 8 is also believed to be independently patentable. Claim 8 further recites notifying a patent staff person in response to the classification information. This step is not taught or suggested by the teachings of *Watanabe* and *Rivette* in combination with the *Schneider* reference. It should be noted that claim 8 is a further limitation of claim 3 which is a further limitation of claim 1.

Claim 10 is also believed to be independently patentable for disclosing a central location that comprises a database coupled to the web server. This in combination with the limitations of claim 1 are not taught or suggested in the *Watanabe*, *Rivette* and *Schneider* references.

Claim 2 is also believed to be independently patentable for disclosing the steps of identifying co-authors and notifying co-authors of the disclosure with their name associated therewith in the system. This in combination with the limitations of Claim 1 are not taught or suggested in the *Watanabe*, *Rivette* and *Schneider* references.

Claim 12 is also believed to be independently patentable. Claim 12 is dependent on claim 11 which is dependent on claim 1. Claim 12 further modifies the step of notifying and

includes generating an e-mail having a hyperlink therein. This in combination with the limitations of claim 1 are not taught or suggested by the combination of the *Watanabe*, *Rivette* and *Schneider* references.

Claim 13 is also believed to be independently patentable and recites the step of viewing the status of the invention disclosure on-line. Applicants respectfully submit that this limitation in combination with that of claim 1 are not taught or suggested by the combination of *Watanabe*, *Rivette* and *Schneider*.

Claim 14 is also believed to be independently patentable and further recites the step of providing a status update via e-mail. This in combination with the limitation of claim 1 is not taught or suggested in combination of the *Watanabe*, *Rivette* and *Schneider* references.

Claim 15 is also believed to be independently patentable and recites that the step of allowing access comprises prompting users for a password. This in combination with the limitations of claim 1 are not taught or suggested by the combination of the *Watanabe*, *Rivette* and *Schneider* references.

Claim 25 is also believed to be independently patentable. Claim 25 modifies the step of notifying as generating an e-mail and providing a hyperlink to the disclosure in the e-mail. This in combination with the limitations of claim 23 are not taught or suggested in the combination of the *Watanabe*, *Rivette* and *Schneider* references.

Claim 26 is also believed to be independently patentable. Claim 26 further recites that the step of prompting an evaluation comprises scheduling an evaluation meeting. Applicants respectfully submit that this limitation is not taught or suggested in claim 23 and therefore makes claim 26 independently patentable.

Claim 27 is also believed to be independently patentable. Claim 27 recites the step of ranking the disclosure. This is not taught or suggested in the combination of the *Watanabe*, *Rivette* and *Schneider* references.

Claim 28 is also believed to be independently patentable. Claim 28 further recites the step of notifying a patent staff person in response to the classification information. This information in combination with the limitations of claim 23 are not taught or suggested in the *Watanabe*, *Rivette* and *Schneider* references.

Claim 29 is also believed to be independently patentable. Claim 29 further comprises the step of prompting a patentability review from the patent staff. The limitation of claim 29 is not found in the combination of the *Watanabe*, *Rivette* and *Schneider* references.

Claim 30 is also believed to be independently patentable. Claim 30 recites that the central location is a database coupled to a web server. This in combination with the recitations of claim 23 are not taught or suggested in the *Watanabe*, *Rivette* and *Schneider* references.

Claim 31 is also believed to be independently patentable. Claim 31 comprises the step of identifying co-authors and notifying co-authors of the disclosure with their name associated therewith in the system. This in combination with the limitations of claim 23 are not taught or suggested in the *Watanabe*, *Rivette* and *Schneider* references.

Claim 32 is also believed to be independently patentable and modifies the step of notifying and includes the step of generating an e-mail having a hyperlink therein. Claim 32 in combination with the *Watanabe*, *Rivette* and *Schneider* references are not taught or suggested.

Claim 33 is also believed to be independently patentable. Claim 33 further comprises the step of viewing the status of the invention disclosure on line. Claim 33 in combination with claim 23 is not taught or suggested in the combination of the *Watanabe*, *Rivette* and *Schneider* references.

Claim 34 is also believed to be independently patentable and contains the step of providing a status updated via e-mail. No teaching or suggestion is found in the *Watanabe*, *Rivette* or *Schneider* references for this step in combination with those of claim 23.

Claim 35 is also believed to be independently patentable. Claim 35 includes prompting users for a password. This in combination with the limitations of claim 23 are not taught or suggested in the *Watanabe*, *Rivette* and *Schneider* references.

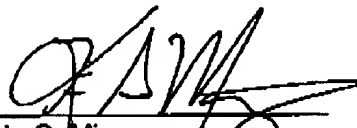
Claim 39 is also believed to be independently patentable. Claim 39 includes the further steps of notifying an evaluator in response to the classification information and prompting an evaluation from the evaluator. This in combination with the limitations of claim 37 are not taught or suggested in the combination of the *Watanabe* and *Schneider* references.

Claim 40 is also believed to be independently patentable. Claim 40 includes the step of notifying a staff person in response to the classification information. This step is also not

taught or suggested in combination with the recitations of claim 37 and the combination of *Watanabe* and *Schneider*.

In light of the above remarks, applicants submit that all rejections are now overcome and the application is now in condition for allowance and expeditious notice thereof is earnestly solicited. Should the Examiner have any questions or comments which would place the application in better condition for allowance, he is respectfully requested to call the undersigned attorney.

Respectfully submitted,



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